

Patents

Technical Focus Group (“TFG”) Meeting Agenda

Date/Time	9 November 2023
Location	Virtual / Stout Street

Participants

MBIE / Intellectual Property Office of New Zealand (“IPONZ”)		<u>Members</u>	
Gaby Cowcill	Chair	Jason Wach	NZ Law Society
Ed Barclay	Team Leader	Tom Robertson	Pipers
Matt Allan	Team Leader	Fiona Pringle	NZIPA / A J Park
Simon Maguire	Principal Patent Examiner	Jonathan Lucas	JAWS
Steve Smith	Principal Patent Examiner	David Nowak	Henry Hughes
Jenny Jebson	Team Leader	Scott Sonneman	DCC
Alicia Baxter	Minutes	David Herman	IPTA / F B Rice
		Laura Hollingsworth	Catalyst
Apologies:		Apologies:	
George Wardle	CGIPP team	Duncan de Geest	NZIPA / A J Park
Ellie McLellan	CGIPP team		

Minutes

Matters arising / previous action items	Update
IPONZ to provide an update on Māori Advisory Committee guidelines.	Ongoing. We are planning changes to the IPONZ Māori IP pages. High-level guidance remains available on the IPONZ website, however substantive work on patent-specific guidance is ongoing. There is now a searching functionality, so users can search for cases that have been referred.
IPONZ to continue to investigate inventor address formatting issues & provide an update next meeting.	Ongoing.

	Current indications are this would be included in the next release after November.
IPONZ to consider including next renewal deadline in patent search results.	Done. This was implemented in the November 2023 release. Display settings will hide this feature by default, this can be changed. Please refer to the instructions accompanying the update or reach out with any questions.
Members to send any further feedback on Regulation 65 manual content to Chloe or Vaughan by end of July. IPONZ will then circulate any additional changes by email before publishing.	Done. Any issues related to transitioning to the new practice, please raise with the examiner or their TL.
Members to send any further feedback on Section 16 manual content to Chloe or Vaughan by the end of July. IPONZ will then circulate any additional changes by email before publishing.	Done. Any issues related to this practice, please raise with the examiner or their TL.
IPONZ to collate & incorporate feedback on Regulation 77 guidance and circulate to TFG for further discussion.	Done. The “apply for a patent” and “request exam” pages, including content on expedited requests under GPPH and regulation 77, have been updated. We’ll continue to update this as appropriate in line with previous feedback. Please reach out if you have any other feedback. We have also made some internal changes to who considers these requests, to improve consistency.
IPONZ Updates	Gaby
<p>Gaby covered general IPONZ updates, including:</p> <ul style="list-style-type: none"> - Recruitment – this is largely complete. - Pendency update – teams are generally in a good position, but next quarter historically sees high input and high levels of leave, so we continue to watch this closely. 	

- General stats – volumes are tracking well for this year. There seems to be a decrease in oppositions and re-examinations, and Gaby sought feedback on what may be influencing this. One member responded citing largely economic considerations including high standards for evidence.
- Upcoming changes – the PCT RO continues to evolve; the designs content update in progress; and a reminder that the next fees review is commencing next year.

Update from MBIE Policy Team

Gaby passed on apologies from George and Ellie that they were unable to attend this meeting.

George provided the following update:

The CGIPP work programme has continued to be focused upon ratification of the NZ-EU FTA. This has required the development of extensive changes to the Geographical Indications (Wine and Spirits) Registration Act 2006, and a few minor changes to the Trade Marks Act 2002. These are being included in an EU FTA Implementation Bill. The aim is for the FTA Implementation Bill to be tabled in Parliament before Christmas.

We are also working towards seeking approval in the new year from the Minister of Commerce and Consumer Affairs for a work programme that includes:

- *Restarting the Copyright Act review, including implementation of NZ-EU FTA's new copyright obligations.*
- *Taking steps towards accession to the Hague Agreement.*
- *Progressing the IP Laws Amendment Bill.*

Feel free to reach out via IPONZ or directly to George or Ellie if you have further questions.

Other practice queries and discussions

Practice guidelines

No practice guidelines were presented for this meeting.

PCT RO change

On 30 October 2023, IPONZ changed when the RO 105 Form (Notification of the IA Number and of the International Filing Date) is made available in ePCT/sent to the applicant. We also updated the website to include what happens a new PCT application is filed with RO/NZ. A member requested more information about the PCT RO change. Specifically, what 'deficiencies' extends to.

Jenny responded that when a PCT application comes into the receiving office, it's reviewed for deficiencies and the applicant will be invited to resolve these before they're given an international filing date. Responses filed on the deadline may be given to resolve these deficiencies.

Gaby confirmed IPONZ had not changed its practice regarding what deficiencies would be raised.

After some discussion, members requested more clarity regarding this process, which IPONZ will take as an action. Gaby also apologised for the timing of change communications, which occurred on the day of the change.

For the benefit of the minutes Jenny provided the following written summary, and IPONZ will look to use this to update its web content as appropriate:

First, we determine if your application meets the requirements of Article 11(1).

If your application meets the requirements of Article 11(1), then the application can be accorded a filing date. We will complete the formalities examination of your new application and send out/make available in ePCT:

- The MBIE invoice,
- RO 105 Form (Notification of the IA Number and of the International Filing Date), and
- The RO 102 form (Notification Concerning Payment of Prescribed Fees).
- Other RO forms such as RO 106 and RO 107 forms if required.

After the fees are paid, PCT RO transmits the application to the RO/IB.

If your application does not meet the requirements of Article 11(1), the application cannot be accorded an international filing date. Issues that can be raised under Article 11(1) would be:

- The applicant lacks, for reasons of residence or nationality, the right to file an international application with the receiving Office.
- The international application is not in the prescribed language.
- The international application does not contain at least the following elements:
 - a) an indication that it is intended as an international application,
 - b) the designation of at least one Contracting State,
 - c) the name of the applicant, as prescribed,
 - d) a part which on the face of it appears to be a description,
 - e) a part which on the face of it appears to be a claim or claims.

In this case, PCT RO will send the applicant an RO 103 form (Invitation to correct the purported International Application) to correct the application under Article 11(1). We will also send the MBIE invoice, RO 102 and any other appropriate forms. We will not send out the RO 105 form at this time.

The application is not transmitted to the RO/IB until the issue is resolved. If the applicant complies with the invitation, as provided in the Regulations, the RO/NZ shall accord as the international filing date the date of receipt of the required correction, and will issue the RO 105 form.

PCT restoration of priority

A member had queried which criteria IPONZ applies when considering requests for restoration of priority.

IPONZ confirmed that the office applies **both** the “unintentional” and the “due care” criteria to such requests.

In light of this feedback, IPONZ will be updating its ‘Apply for a patent’ and ‘Filing a Treaty Application’ web pages so they link out to relevant sections of the PCT Applicants Guide.

Any other business:

Unity guidelines

Following the brief discussion at the last meeting, a member repeated a call for unity guidance. There is a historic practice note on unity (Journal 1414) which stated that IPONZ would generally follow unity decisions in PCT reports, and members noted that consistent practices on unity are particularly important given the 5-year deadline on filing divisionals.

Members agreed that guidance on unity would be useful, to be better able to advise clients. IPONZ took an action to feed this priority back to the team.

Swiss-type claims to non-humans

A member suggested guidelines on Swiss-type claims that reflect current IPONZ practice. The member discussed some recent clarity objections against Swiss-type claims directed to non-humans. The member referred to *Mylan Health Pty Ltd v Sun Pharma ANZ Pty Ltd* [2020] FCAFC 116 which discusses differences between method of treatment claims and Swiss-type claims. IPONZ practice was compared to overseas offices where claims to both are allowable.

Simon responded that IPONZ differs from other jurisdictions (particularly Europe) because the method of treatment exclusion only applies to humans. The meeting briefly discussed how Swiss-type claims were intended to apply to excluded subject matter.

The meeting agreed that more clarity around this topic would be beneficial. IPONZ noted there is some work underway on this already, and took an action to feed this priority back to the team.

Any Other Business

The date of the next meeting

This was agreed as Tuesday 19th March.

TIME	Close of Meeting	
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